

## Remarks

### The claimed invention

The present invention is directed to a novel fault current limiter comprising a superconducting composite. The composite includes an oxide superconducting member and an electrically conductive member substantially surrounding the superconducting member. (The electrically conductive member is hereinafter referred to as the "matrix." This designation is solely for convenience and is not intended to limit the structure or function of the member).

The superconducting composite has an operating current selected to be greater than or equal to about one-half the critical current of the superconducting member, and less than or about equal to the critical current of the superconducting member. The oxide superconducting member and the matrix are selected such that when the composite experiences a fault current of about 3-10 times the operating current, the electric field in the composite is in the range of about 0.05-0.5 V/cm. Since the minimum value of the operating current is about half the critical current, and the fault current is at least about three times the operating current, the fault current must exceed the critical current of the superconducting member.

In typical use as fault current limiters, the oxide superconductor is selected to have an operating current slightly in excess of normal peak loads for a system. In the event of a short-circuit fault current, the critical current is rapidly exceeded, and the superconducting component reverts to its normal high resistivity. Current is then shunted through the matrix, which has a sufficiently high resistivity to exhibit the claimed electric fields.

### Rejections under 35 U.S.C. § 102

Claims 1-5, 10, 11, 18, and 25 stand rejected under 35 U.S.C. § 102(b) as anticipated by Shiga. This rejection is respectfully traversed for the reasons set forth below.

Shiga describes an oxide superconductor wire and a method of making such a wire. The wire includes both a low conductivity and a high-conductivity sheath surrounding a superconducting member. (As used by Shiga, "conductivity" refers either to thermal or to electrical conductivity). The low conductivity portion suppresses eddy currents and reduces

coolant evaporation, while the high conductivity portion acts as a heat sink and as a current bypath (col. 1, lines 21-43; col. 2, lines 45-55; col. 5, lines 38-53).

Independent claim 1, and claims 2-5, 10, 11, 18, and 25 which depend directly or indirectly from claim 1, recite a superconducting composite comprising an oxide superconducting member and an electrically conductive member substantially surrounding the oxide superconducting member. The composite must meet certain current-electric field limitations described above.

The Office Action states that the claimed range of electric field and the range of operating current are inherent properties of the superconductor as described by Shiga. Applicant respectfully disagrees. "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Continental Can v. Monsanto*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), quoting *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981) (emphasis in original).

The claimed ranges require careful engineering of both superconducting oxide and matrix (as well as any other element that may be electrically connected in parallel with the composite, such as a stabilizing element, recited in claim 5), so that these elements can work together to limit fault currents. Shiga provides no suggestion that the electric field can or should be controlled in the event of a current in excess of the critical current, or even any suggestion that a superconducting composite might experience a fault current. The Office Action provides absolutely no evidence that the recited fields would necessarily be achieved using the composites of Shiga. In fact, because Shiga suggests that a portion of the matrix should be composed of high-conductivity material, it is likely that the electric field would not reach the minimum recited value of 0.05 V/cm, since most current would be shunted through this portion of the composite at a relatively low electric field. Thus, Shiga cannot be considered to disclose or suggest this structural limitation to the pending claims. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

#### Rejections under 35 U.S.C. § 103

Claims 6-9, 12-17, 19-24, and 26-31 stand rejected under 35 U.S.C. § 103(a) as obvious over Shiga in view of Fillunger. In addition, although the patent is not cited by number or

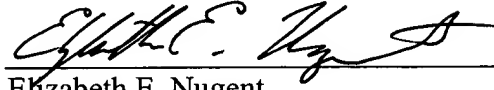
explicitly made part of the rejection, the Office Action makes reference to “Puhn” in connection with the rejection of claims 7 and 9. Applicant is proceeding on the assumption that this refers to U.S. Patent No. 4,994,633, the only reference of record corresponding to that name, and that it was intended to reject claims 7 and 9 under 35 U.S.C. § 103(a) over Shiga in view of both Fillunger and Puhn. If this assumption is not correct, Applicant requests clarification of the rejection in another nonfinal Office Action. All rejections under 35 U.S.C. § 103(a) are respectfully traversed for the reasons set forth below.

As discussed above, Shiga does not disclose or suggest the limitations on electric field in the presence of a fault current recited in claim 1, from which all claims rejected under 35 U.S.C. § 103(a) depend. This defect is not remedied by Fillunger or Puhn. Fillunger describes a non-oxide (low  $T_c$ ) superconducting cable, which is mechanically reinforced by solder (Fig. 4; col. 3, lines 53-57) and a stainless steel plate (Fig. 4 at 12; col. 3, lines 51-52). Both the stainless steel plate and the solder are disclosed to provide mechanical stabilization, rather than thermal stabilization. Puhn is also directed to mechanical stabilization of non-oxide (low  $T_c$ ) superconductive cables. Neither Fillunger nor Puhn contains any suggestion that the *electrical* or *thermal* properties of the cables can be optimized in the presence of fault currents, as recited in the pending claims, let alone suggesting particular desirable values for the electric field (all claims), heat capacity (claims 12-17 and 26-31), or heat transfer coefficient (claims 19-24 and 26-31).

For at least these reasons, Applicant respectfully requests that all rejections under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Please charge any fees associated with this filing, or apply any credits, to our Deposit  
Account No. 03-1721.

Respectfully submitted,



Elizabeth E. Nugent

Registration Number 43,839

Date: June 10, 2003

Choate, Hall & Stewart  
Exchange Place  
53 State Street  
Boston, MA 02109  
(617) 248-5000  
3569749\_1.DOC